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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,678	05/04/2005	Minoru Nakayama	3103-109	2059
<div>66458      7590      10/18/2007</div> <div>WATCHSTONE P+D, PLC</div> <div>1250 CONNECTICUT AVENUE, N.W.</div> <div>SUITE 700</div> <div>WASHINGTON, DC 20036-2657</div>				
			<div>EXAMINER</div> <div>NGUYEN, SON T</div>	
			<div>ART UNIT</div> <div>3643</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE</div> <div>10/18/2007</div>	<div>DELIVERY MODE</div> <div>PAPER</div>

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/511,678	Applicant(s) NAKAYAMA ET AL.	
	Examiner Son T. Nguyen	Art Unit 3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 23 and 25-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23,25-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 23,25-44** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. The claims as amended are still not in conformance to U.S. practice. For example, without the "comprising" or similar language, the claims appear to claim a display device in combination with at least one creature models, i.e. "A display device..., and at least one creature...", and not actually a display device comprising at least one creature models. In addition, without "comprising" or similar language, the claims could just merely be interpreted as claiming only a display device because the limitation after a display device is not positively recited and appears to be merely functional or intended use recitation "for appreciation...".

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 23,25,26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Houcho (JP2003-961 on form PTO-1449) in view of Chia et al. (6617078).

For claims 23,25,26, Houcho teaches a display device comprising creature models 2 in a pseudo space (the tank), the models are provided with a driving portion (as shown in fig. 6, the electronic components) and coils 6,11 which generate electromagnetic field for generating power to move the models. However, Houcho is silent about the driving portion being composed of polymeric actuator elements in which two metal layers are laminated through a polymeric electrolyte therebetween.

Chia et al. teach well known driving portion, i.e. battery/lithium cells, to produce power used in a variety of electronic devices. The driving portion is lithium cells made from polymeric electrolytes that are laminated in between metal layers (col. 1, lines 49-60). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ polymeric actuator elements in which two metal layers are laminated through a polymeric electrolyte therebetween as taught by Chia et al. as the preferred driving portion of Houcho in order to provide higher energy/voltage, flexible and robust driving portion to move the models (col. 1, lines 55-60 of Chia et al.).

For claims 27-30,33-36,39-42, Houcho as modified by Chia et al. (emphasis on Houcho) further teaches the models resembling an aquatic animal such as a fish 2b, a plurality of models such as the fish and the rocket, and a flying object such as the rocket 2a.

For claims 31,37,43, Houcho as modified by Chia et al. (emphasis on Houcho) further teaches the pseudo space is an underwater space (see abstract).

For claims 32,38,44, Houcho as modified by Chia et al. is silent about the pseudo space being a non-underwater space. It would have been an obvious substitution of functional equivalent to substitute the underwater space of Houcho as modified by Chia et al. with a non-underwater space, since a simple substitution of one known element for another would obtain predictable results. KSR International Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739, 1740, 82 USPQ2d 1385, 1395, 1396 (2007).

***Response to Arguments***

5. Applicant's arguments filed 8/3/07 have been fully considered but they are not persuasive.

**Applicant argued that Houcho does not teach a driving portion composed of polymeric actuator elements in which two metal layers are laminated through a polymeric electrolyte. In addition, Chia et al. merely teach a battery.**

In analyzing the claim language, the driving portion can be merely interpreted as a battery to drive or move the model. The claim language does not indicate or define that the models are made out of a material having two metal layers laminated through a polymeric electrolyte therebetween. Take claim 1 for an example, the claim states that the models are "provided" with a driving portion "in" the models. This can be interpreted as a battery in the models to move them, which these models are known to have. Further on, the claim define the driving portion as to "include at least one polymeric actuator elements in which two metal layers laminated through a polymeric electrolyte therebetween", which again, a battery does include two metal layers laminated through

a polymeric electrolyte therebetween as taught by Chia et al. (see col. 1, lines 49-60 of Chia et al.).

Note that no where in the independent claims does Applicant define that the models are made out of a material having two metal layers laminated through a polymeric electrolyte therebetween. Based on the claimed language, one can conclude that the invention is a model with a driving portion inside, the driving portion include two metal layers laminated through a polymeric electrolyte therebetween, which perfectly describes a model with a battery inside, the battery being made out of two metal layers laminated through a polymeric electrolyte therebetween. Thus, the combination of Houcho as modified by Chia et al. does teach the limitation in the claims, for Houcho teaches the models with battery therein, but silent about the battery having two metal layers laminated through a polymeric electrolyte therebetween, to which Chia et al. teach a battery with two metal layers laminated through a polymeric electrolyte therebetween. The combination of Houcho as modified by Chia et al. does produce a driving portion that physically moves the model.

**Applicant stated that information from Applicant's website is provided for the Examiner to understand the invention better.**

The Examiner greatly appreciates the information. The Examiner does fully understand the invention; however, again, the claim language does not defined the invention well. Nothing in the claim language indicates that the material used in making the model is actually the two metal layers laminated through a polymeric electrolyte therebetween. If Applicant reads all independent claims, nothing in these claims define

such material. Therefore, the claims are interpreted as broadly as they are written. Limitations appearing in the specification but not recited in the claim should not be read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003). *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.").

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is 571-272-6889. The examiner can normally be reached on Mon-Thu from 10:00am to 5:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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A handwritten signature in black ink, appearing to read 'Son T. Nguyen', with a stylized flourish at the end.

Son T Nguyen  
Primary Examiner  
AU 3643